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Eric Joseph Bilskie

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THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER

PETERSON, KENNETH E

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/811,160
Filing Date: March 26, 2004
Appellant(s): BILSKIE ET AL.

Peter D. Meyer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03 February 09, and amended on 11 March 09 and 28 April 09, appealing from the Office action mailed 31 July 08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,506,575	McCay et al.	March 1985
5,308,217	Pienta	May 1994
5,759,350	Pyron et al.	June 1998
6,761,098	Esping et al.	July 2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,3-7,9,11-14,16,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable under McCay in view of Esping.

McCay et al.'575 shows a core slabber with most of the recited limitation including a cutter (30) mounted on an axial traversing element (23,31), which in turn is mounted on a radial traversing element (11). The feeler 80 constitutes a controller that determines a maximum depth of cut (paragraph spanning columns 3 and 4).

McCay lacks an integral transport element with two engaging portions, but it is well known in the art to employ an integral transport element, as taught by Esping et al.'098, who shows in figure 2 a pair of engagement pins (18) for transporting the roll upward to the slabbing position (lines 28-30, column 2). It would have been obvious to one of ordinary skill in the art to have modified McCay by *replacing* his roll support with Esping's integral transport/roll-support element, as taught by Esping, in order to facilitate lifting the heavy roll into the slabbing position.

The “feed section” is below the roll in McCay’s figure 2. The pins 18 lift the roll from the “feed section” up to the slabbing position.

The “discharge section” can be any spot nearby McCay’s machine. The roll “may be conveyed” to the discharge section. Note that Appellant has claimed no structure for performing this task. It could be rolled there manually.

The “material removal section” is wherever the conveyor takes the material (lines 33,34, column 2).

Claims 1,3-5,9,11,12,16 are rejected under 35 U.S.C. 103(a) as being unpatentable under Pyron et al. in view of Pienta.

Pyron shows a core slabber with most of the recited limitation including a cutter (12) mounted on an axial traversing element (164,180) and a radial traversing element (145,150). The sensor (lines 5-7, column 6) constitutes a controller that determines a maximum depth of cut.

On lines 39-43 of column 5, Pyron discusses transporting the core from one apparatus onto the core slabbing apparatus, but Pyron does not disclose any detail of this transporting mechanism and whether or not it has any core engaging portions. However, Pienta shows that it is well known in the art to employ a transport element having core engaging portions when one needs to move large rolls of material from one apparatus to the next (lines 43-45, column 1).

It would have been obvious to one of ordinary skill in the art to have provided Pyron with Pienta’s transport element, in order to facilitate lifting the heavy roll into the

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slabbing position. Pyron clearly needs some mechanism to do this, and Pienta suggests himself on lines 43-45 of column 1. Pyron could be converted to use Pienta's hollow cores, since hollow cores and solid cores are known equivalents.

The “feed section” is where the roll came from.

The “discharge section” is wherever the roll goes after it is stripped. The roll “may be conveyed” to the discharge section. Note that Appellant has claimed no structure for performing this task. It could be rolled there manually.

The “material removal section” is 25 or wherever the material goes.

In regards to claim 16, there is the recitation that the transporting element be “integral” with the slabbing apparatus. The choice of whether or not to make Pienta’s transporting element integral or separable with Pyron’s core slabber is a decision that can be made by one of ordinary skill in the art based on whether or not the transporting element is needed exclusively for this function, or if it might be needed elsewhere as well.

Another way of looking at this is to modify Pienta in view of Pyron. If one needed to remove the paper from Pienta's roll, one would need merely add the cutter from Pyron's figure 2.

Claims 1,3-7,9,11-14,16,18,19 are rejected under 35 U.S.C. 103(a) as being unpatentable under Pyron et al. in view of Pienta, as set forth above, and further in view of McCay.

In regards to at least claims 6,7,13,14,18 and 19, Pyron's cutter is mounted on the radial elements and *then* on the axial element, as opposed to vise versa. Of course, this works either way as exemplified by McCay. It would have been obvious to one of ordinary skill in the art to have modified Pyron by making the cutter be mounted on the axial element, and *then* on the radial element, as taught by McCay, as this is just one out of two possible ways to movable mount the cutter.

This modification is unnecessary, but in regards to all the claims, Pyron shows a sensor (lines 5-7, column 6) that constitutes a controller that determines a maximum depth of cut. However, there are many ways to do this, and McCay shows a different way, namely there is a feeler 80 that constitutes a controller that determines a maximum depth of cut (paragraph spanning columns 3 and 4). It would have been obvious to one of ordinary skill in the art to have replaced Pyron's controller with McCay's controller, since they are art recognized equivalents known for the same purpose.

(10) Response to Argument

Firstly, Examiner notes that Appellant has no claim-specific arguments. Accordingly, Examiner will address the arguments only within the context of the broadest claim, claim 1. It is presumed that the remaining claims will stand or fall with claim 1.

McCay in view of Esping

Appellant argues the McCay in view of Esping rejection, stating that there is no *reason* to combine the two references. More particularly, Appellant espouses the many virtues of McCay's cantilevered roll support (18), and states that there is no reason anyone would want to replace it with Esping's roll support (also 18). Examiner will herewith set forth two reasons to make this modification.

1 – Waste paper rolls weigh an enormous amount, sometimes over a ton. It would require a forklift or some other heavy machinery to hoist the waste paper roll onto McCay's cantilevered roll support. Contrarily, the device of Esping's figure 2 requires no additional heavy lifting equipment, instead the chucks 18 can lift the waste paper roll directly off of the floor and move it into the desired position. Accordingly, one of ordinary skill in the art would be motivated to employ Esping's lifting chucks (18) in lieu of McCay's roll support, in order to be able to lift the roll into place without needing extra heavy lifting machinery.

2 – The roll holder (18) of McCay and the roll holder of Esping (18) are art recognized equivalents known for the same purpose. While each has it's separate charms, it is easy to see from the two references that they achieve the exact same function, and one of ordinary skill would recognize that one could be swapped for the other. As per MPEP 2144.06II, "SUBSTITUTING EQUIVALENTS KNOWN FOR THE SAME PURPOSE", this case matches the facts shown in the Smith v. Hayashi case. Not only do McCay's and Esping's roll supports perform the same function, but they do so in within the exact same field of endeavor, namely core slabbing. As stated in

2144.06II, *“An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious”*.

Examiner notes that Appellant has, over the course of 4 actions by the Examiner, continually referred to Esping's figure 1 as if it was part of the combination. Examiner has repeatedly corrected Appellant on this, but as seen on page 6 of Appellant's arguments, Appellant is still trying to visualize parts of Esping's figure 1 (elements 7 and 8) combined with McCay. To be clear (once again), Examiner is relying of the embodiment of Esping's figure 2. The embodiment of figure 1 is irrelevant to the rejection. Accordingly, Appellants arguments with regards to Esping's figure 1 will not be addressed.

Appellant argues that McCay's roll support has a critical function of locking the roll in place rotationally and axially, and therefor Esping's roll holder would not be a good substitute. On the contrary, Esping's roll support (18) clearly has all the necessary features. The roll cannot move axially because the chucks 18 are on the sturdy vertical supports. Esping is silent on the rotational locking, but Examiner notes that this feature is not claimed, and Examiner also notes that Esping's device performs the exact same cutting action as does McCay's, so therefor either Esping has the rotational locking feature or it is not critical.

Pyron in view of Pienta, with or without McCay.

Appellant argues against the Pyron in view of Pienta rejection, stating that Pyron's roll of material has a solid core that could not be used in conjunction with the core engaging inserts of Pienta.

As seen in Pyron and Pienta, and in all the other art of record, rolls of material comes in two varieties, those with solid cores, and those with hollow cores. To take advantage of Pienta's loading system, Pyron would have to switch from the solid core type to the hollow core type. Making this switch would not be an impediment to obviousness because these are art recognized equivalent ways of doing the same thing. See MPEP 2144.06II, where this case once again matched the Smith v. Hayashi fact pattern. One of ordinary skill would have no problem with the engineering involved with switching from one system to the other, since they are both so well known. Examiner has made this point previously, and notes that Appellant has made no showing of why it would not be obvious to switch Pyron over to the hollow core system.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kenneth Peterson/

Expert Primary Examiner, Art Unit 3724

Conferees:

/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724

/Joseph J. Hail, III/

Supervisory Patent Examiner, Art Unit 3723